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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,216	01/11/2002	Hideya Kinoshita	1417.1002 CIP	6978

21171 7590 09/16/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,216

Applicant(s)

KINOSHITA ET AL.

Examiner

Rabon Sergent

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/267,673.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The amendment to the abstract of July 2, 2003 has not been entered, because the amendment fails to comply with the provisions of 37 CFR 1.121. Correction is required.
2. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support has not been provided for claiming that the polyurethane foam is “dibutyl cresol-free”. Applicants have failed to establish that “substantially free” encompasses “free”.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over St. Clair et al. ('781) in view of Ishii et al. ('744) or Duffy et al. ('602).

St. Clair et al. disclose flexible polyurethane foam derived from the reaction of polyisocyanate with polyol, which meets applicants' claimed polyol, in the presence of foaming agent, catalyst, surfactant, and an antioxidant/stabilizer blend comprising relatively high molecular weight hindered phenolic compounds, which, in view of their molecular weights, are considered to be more closely related to applicants' claimed antioxidants than dibutyl cresol; phosphite ester secondary antioxidant; and benzotriazole UV absorbing agent. See abstract and columns 3-5, especially column 3, lines 57+ and column 4, lines 1-28.

5. Though St. Clair et al. disclose the use of relatively high molecular weight hindered phenol antioxidants at column 3, lines 57+, patentees fail to disclose the use of applicants' specifically claimed hindered phenol antioxidants. However, applicants' claimed hindered phenol antioxidants were known antioxidants for polyurethanes at the time of invention. Ishii et al. disclose the use of 3,9-bis[1,1-dimethyl-2-[3-(3-tert-butyl-4-hydroxy-5-methylphenyl)propionyloxy]ethyl]-2,4,8,10-tetraoxaspiro[5.5]undecane as an antioxidant for polyurethanes, and Duffy et al. disclose the use of 2,2'-thiodiethylene bis[3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate] (Irganox 1035) as an antioxidant for use within polyurethanes. Duffy et al. further specifically teach the advantages of using Irganox 1035 and similar antioxidants as a replacement for the BHT. See columns 2 and 3.

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6. Therefore, since it has been held that it is *prima facie* obvious to utilize a known component for its art recognized purpose (*In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244), the position is taken that it would have been obvious to incorporate the antioxidants of the secondary references into the composition of St. Clair et al., so as to arrive at the instant invention.

7. Applicants' response has been considered; however, it is insufficient to overcome the prior art rejection for the following reasons. Firstly, despite applicants' argument, the examiner has argued that it would have been obvious to utilize the antioxidants of the secondary references as the hindered phenolic compounds of column 3, lines 61+ of St. Clair et al., rather than the polydiene diols of St. Clair et al. Secondly, with respect to applicants' arguments concerning Ishii et al., applicants have misinterpreted the reference. Applicants' claimed antioxidant is the compound recited at column 1, lines 56-65 of Ishii et al. The passage within column 2, lines 3-10 of Ishii et al. pertains to the production of applicants' antioxidant. A comparison of the text within the patent and applicants' argument at page 4 of the response indicates that applicants' interpretation is incorrect. Lastly, with respect to Duffy et al., the motivation for using the claimed antioxidant within St. Clair et al. stems directly from Duffy et al., wherein the advantage of using the claimed antioxidant in lieu of dibutyl cresol is clearly set forth. The motivation for making the substitution recited by the prior art need not be the same as the reason for substitution relied upon by applicants.

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8. Applicants' comparative examples have been considered; however, the comparative examples are not considered to be representative of the closest available art, namely St. Clair et al.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
September 14, 2003


RABON SERGENT
PRIMARY EXAMINER